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EXAMINER

STORK, KYLE R

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,664

Applicant(s)

SCHROEDER, PAUL B.

Examiner

Kyle R. Stork

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This non-final office action is in response to the appeal brief filed 20 September 2005.
2. Claims 1-49 are pending. Claims 1, 9, 21, 30, 36, 41, 47, 48, and 49 are independent claims. The rejection of claims 1-49 under 35 U.S.C. 103 have been withdrawn.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 9-10, 30, 36-37, and 47-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Khan et al. (US 6460038, filed 24 September 1999, hereafter Khan) and further in view of Murphy et al. (US 6096096, filed 13 December 1996, hereafter Murphy) and further in view of Shwartz et al. (US 6243071, filed 3 November 1993, hereafter Shwartz).

Regarding independent claim 1, Khan discloses a method in a data processing system for creating bookmarks (in col. 18, lines 15-65, the invention creates bookmarks), comprising: receiving a request to create a new bookmark for a document (in order to create a bookmark it is inherently necessary that a creation request is received); creating a bookmark link(since the reference bookmark is accessed remotely,

it is necessary to create a link to it); and linking the bookmark link to the reference bookmark (linking the bookmark link is a necessary part of creating the bookmark link).

Khan fails to specifically disclose wherein the link is a symbolic link. However, Murphy discloses the use of symbolic links (column 9, lines 10-55). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Khan and Murphy, since it would have facilitated access to data on other file systems.

Khan further fail to disclose determining whether a reference bookmark already exists for the document. However, Shwartz discloses determining whether a reference bookmark already exists for the document (Figure 15, item 320; column 18, line 60-column 19, line 19). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Khan and Shwartz, since it would have allowed a user to avoid creating several static bookmarks to the same resource (Shwartz: column 18, lines 60-65).

Regarding independent claim 9, it is essentially the same as claim 1 except that there is no determining step, and since it is broader, it is rejected under the same rationale.

Regarding dependent claim 10, identifying a reference bookmark inherently involves presenting at least one existing bookmark; receiving a selection of a reference bookmark from the at least one existing bookmark because there is no logical way to accomplish this task other than assembling a group of candidates and choosing one.

Regarding independent claim 30, it is an apparatus that performs the method of claim 1 and it is rejected under the same rationale.

Regarding independent claim 36, it is an apparatus that performs the method of claim 9 and it is rejected under the same rationale.

Regarding dependent claim 37, it is an apparatus that performs the method of claim 10 and it is rejected under the same rationale.

Regarding independent claim 47, it is a computer program in a computer-readable medium that encodes the method of claim 1 and is rejected under similar rationale.

Regarding independent claim 48, it is a computer program in a computer-readable medium that encodes the method of claim 9 and is rejected under similar rationale.

5. Claims 2-3, 5, 15-16, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, and Shwartz, and further in view of Bauersfeld (USPN 5,917,491—filing date 8/29/1997).

Regarding dependent claim 2, Khan Murphy, and Shwartz fail to disclose receiving a name for the bookmark link. However, Bauersfeld, in col. 3, lines 20-30, discloses that links have name to aid in identifying them. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Bauersfeld's practice of naming links into Khan in order aid in identifying links.

Regarding dependent claim 3, Khan Murphy, and Shwartz fail to disclose receiving a description for the bookmark link. However, Bauersfeld, in col. 3, lines 20-30, discloses that links have descriptions to aid in storing background information about them. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Bauersfeld's practice of naming links into Khan in order aid in storing background information about them.

Regarding dependent claim 5, Khan Murphy, and Shwartz fail to disclose that each bookmark includes a uniform resource locator for the document. However, Bauersfeld, in col. 3, lines 10-20 discloses that bookmarks have URLs in order to aid in retrieving the web page associated with the bookmark subsequently. It would have been obvious to one of ordinary skill in the art at the time of the invention to use URLs with the bookmarks in Khan after the manner of Bauersfel in order to aid in retrieving the web page associated with the bookmark subsequently.

Regarding dependent claim 15, it contains the same limitation as claim 5 and is rejected under the same rationale.

Regarding dependent claim 16, it incorporates the determination step from claim 1 into claim 15 and it is rejected under the same rationale.

Regarding independent claim 32, it is an apparatus that performs the method of claim 5 and it is rejected under the same rationale.

6. Claims 4, 20, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, and Shwartz, further in view of Reiter (USPN 5,642,503—filing date 12/15/1993).

Regarding dependent claim 4, Khan, Murphy, and Shwartz fails to disclose that the step of linking the bookmark link to the reference bookmark comprises storing a pointer to the reference bookmark in the bookmark link. However, Reiter in col. 3, lines 65-67 and col. 4, lines 1-20 discloses how linking involves storing a pointer (see col. 4 lines 13-15) in order to efficiently and elegantly record relevant linking information. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Khan by linking with a pointer as in Reiter in order to efficiently and elegantly record relevant linking information.

Regarding dependent claim 20, it incorporates the limitations of claim 4 into claim 9 and is rejected under the same rationale.

Regarding dependent claim 31, it is an apparatus that performs the method of claim 4 and it is rejected under the same rationale.

7. Claims 6, 17, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, Shwartz, and Bauersfeld, further in view of Himmel et al. (USPN 6,037,934—filing date 11/21/1997), hereinafter Himmel.

Regarding dependent claim 6, Khan, Murphy, and Shwartz and Bauersfeld fail to disclose that the step of determining whether a reference bookmark already exists for the document comprises comparing the uniform resource locator of the bookmark to the

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uniform resource locator of each existing bookmark. However, Himmel discloses in col. 17, lines 55-65 that URLs are compared to determine if bookmarks exist, in order to detect redirection conditions. It would have been obvious to one of ordinary skill in the art at the time of the invention to compare URLs as in Himmel in the context of Khan in order to detect redirection conditions.

Regarding dependent claim 17, it incorporates the limitations of claim 6 into claim 16 and is rejected under the same rationale.

Regarding independent claim 33, it is an apparatus that performs the method of claim 6 and it is rejected under the same rationale.

8. Claims 7-8 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, and Shwartz, further in view of Isreal et al. (USPN 6,330,007 B1—filing date 12/18/1998), hereinafter Isreal.

Regarding dependent claim 7, Khan, Murphy, and Shwartz fails to disclose that if a reference bookmark already exists, prompting a user whether to create the bookmark link. However, Isreal discloses in col 12, lines 30-45 prompting the user if duplication of a screen ID is found. This is analogous art because in both cases duplication occurs and prompting is the response. It would have been obvious to one of ordinary skill in the art at the time of the invention to add Isreal's feature of prompting upon duplication to Khan because it gives the user a chance to select an appropriate response to the case when duplication occurs.

Regarding dependent claim 8, Khan, Murphy, and Shwartz and Isreal fail to disclose that the step of creating the bookmark link comprising creating the bookmark link in response to a user's request to create the bookmark link. However, it was notoriously well known in the art at the time of the invention that when a user is prompted for an action, it is obvious to carry out the action if the user decides to do the action. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention to actually create the link if the user selected this course action at the prompt because this would satisfy the user's expectations.

Regarding dependent claim 34, it is an apparatus that performs the method of claim 7 and it is rejected under the same rationale.

Regarding dependent claim 35, it is an apparatus that performs the method of claim 8 and it is rejected under the same rationale.

9. Claims 11-14 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, and Shwartz, further in view of Crandall et al. (USPN 6,321,228 B1—filing date 8/31/1999), hereinafter Crandall.

Regarding dependent claim 11, Khan Murphy, and Shwartz fail to disclose the step of presenting at least one existing bookmark comprises presenting the at least one existing bookmark in a tree structure. However, Crandall discloses in col. 4, lines 1-10 that bookmarks have a tree structure. It would have been obvious to one of ordinary skill in the art at the time of the invention to present the bookmarks in a tree structure in

the manner of Crandall in order to efficiently store the bookmark information in a hierarchy.

Regarding dependent claim 12, Khan, Murphy, and Shwartz and Crandall fail to explicitly disclose that the step of receiving a selection of a reference bookmark comprises receiving the selection of the reference bookmark in the tree structure. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have this be the case based on claim 11, wherein the bookmarks are presented in a tree structure, and hence it would be obvious to receive the reference bookmark via the tree structure because this would match the user's clear expectations.

Regarding dependent claim 13, Khan, Murphy, and Shwartz fail to disclose displaying a symbolic representation of the bookmark link in the tree structure. However, Crandall discloses displaying a symbolic representation of the bookmark link in the tree structure in col. 6, lines 30-45. It would have been obvious to one of ordinary skill in the art at the time of the invention to display a symbolic representation of the bookmark link in the tree structure as in Crandall in the context of Khan '038 in order to provide the user with a tool for visualizing the bookmark structure.

Regarding dependent claim 14, Khan, Murphy, and Shwartz and Crandall fail to disclose that modifications to the reference bookmark are displayed in relation to the symbolic representation of the bookmark link in the tree structure. However, it was notoriously well known in the art at the time of the invention that users expect displayed material to be an accurate representation of the underlying data structure. Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention to

have modifications to the reference bookmark be displayed in relation to the symbolic representation of the bookmark link in the tree structure in order to have the displayed material be an accurate representation of the underlying data structure.

Regarding dependent claim 38, it is an apparatus that performs the method of claim 11 and it is rejected under the same rationale.

Regarding dependent claim 39, it is an apparatus that performs the method of claim 12 and it is rejected under the same rationale.

Regarding dependent claim 40, it is an apparatus that performs the method of claim 13 and it is rejected under the same rationale.

10. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, and Shwarts, further in view of Isreal, further in view of Bauersfeld.

Regarding dependent claim 18, it incorporates the limitations of claim 7 into claim 16 and is rejected under the same rationale.

Regarding dependent claim 19, it incorporates the limitations of claim 8 into claim 16 and is rejected under the same rationale.

11. Claims 21-22, 41-42, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, and Shwarts further in view of Khan et al. (USPN 6,427,175 B1—filing date 9/24/1999), hereinafter Khan '175.

Regarding independent claim 21, the claim is analogous to claim 1 except that instead of bookmarks, bookmark folders are manipulated. However, Khan '175

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discloses the use of bookmark folders as organizational tools for bookmarks in lines 1-20 of the Abstract. It would have been obvious to one of ordinary skill in the art at the time of the invention to use bookmark folders in the context of Khan in the manner of Khan '175 in order to take advantage of bookmark folders' applicant as organizational tools for bookmarks.

Regarding dependent claim 22, it modifies claim 21 in a way analogous to the way in which claim 10 modifies claim 9, and is rejected under similar rationale.

Regarding independent claim 41, it is an apparatus that performs the method of claim 21 and it is rejected under the same rationale.

Regarding dependent claim 42, it is an apparatus that performs the method of claim 22 and it is rejected under the same rationale.

Regarding independent claim 49, it is a computer program in a computer-readable medium that encodes the method of claim 21 and is rejected under similar rationale.

12. Claims 23-26 and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, Shwarts, and Khan '175, further in view of Crandall.

Regarding dependent claim 23, it modifies claim 22 in a way analogous to the way in which claim 11 modifies claim 10, and is rejected under similar rationale.

Regarding dependent claim 24, it modifies claim 23 in a way analogous to the way in which claim 12 modifies claim 11, and is rejected under similar rationale.

Regarding dependent claim 25, it modifies claim 23 in a way analogous to the way in which claim 13 modifies claim 11, and is rejected under similar rationale.

Regarding dependent claim 26, it modifies claim 25 in a way analogous to the way in which claim 14 modifies claim 13, and is rejected under similar rationale.

Regarding dependent claim 43, it is an apparatus that performs the method of claim 23 and it is rejected under the same rationale.

Regarding dependent claim 44, it is an apparatus that performs the method of claim 24 and it is rejected under the same rationale.

Regarding dependent claim 45, it is an apparatus that performs the method of claim 25 and it is rejected under the same rationale.

Regarding dependent claim 46, it is an apparatus that performs the method of claim 26 and it is rejected under the same rationale.

13. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, Shwartz, and Khan '175, and further in view of Bauersfeld (USPN 5,917,491—filing date 8/29/1997).

Regarding dependent claim 27, it modifies claim 21 in a way analogous to the way in which claim 2 modifies claim 1, and is rejected under similar rationale.

14. Claims 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, Murphy, Shwartz, and Khan '175, and further in view of Bauersfeld.

Regarding dependent claim 28, it modifies claim 21 in a way analogous to the way in which claim 3 modifies claim 1, and is rejected under similar rationale.

15. Claims 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khan Murphy, Shwartz, and Khan '175, and further in view of Reiter (USPN 5,642,503—filing date 12/15/1993).

Regarding dependent claim 29, it modifies claim 21 in a way analogous to the way in which claim 4 modifies claim 1, and is rejected under similar rationale.

Response to Arguments

16. Applicant's arguments with respect to claims 1-49 have been considered but are moot in view of the new ground(s) of rejection.

As disclosed above, the Shwartz reference has been added to address the applicant's claim limitations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER